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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/461,090 | 12/14/1999 | AXEL ULLRICH | 2923-0347 | 3321 |
| 6449 | 7590 | 03/03/2005 | EXAMINER | |
| ROTHWELL, FIGG, ERNST & MANBECK, P.C. | | | LU, FRANK WEI MIN | |
| 1425 K STREET, N.W. | | | ART UNIT | |
| SUITE 800 | | | PAPER NUMBER | |
| WASHINGTON, DC 20005 | | | 1634 | |

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|--------------------------------------|---------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 09/461,090 | Applicant(s) ULLRICH ET AL. | |
| | Examiner Frank W. Lu | Art Unit 1634 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☒ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 22-31,33-36 and 38.

Claim(s) withdrawn from consideration: 37.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

DETAILED ACTION

ADVISORY ACTION

1. The proposed amendments filed on February 16, 2004 have been fully considered but will not be entered because: (1) they raise new issues that would require further consideration and/or search; and (2) they raise the issue of new matter.

Response to Arguments

I. In page 7, second paragraph of applicant's remarks, applicant argues that the amendment on claim 22 has overcome the objection.

This argument has been fully considered and is moot since claim 22 is amended by changing the phrase "a receptor tyrosine" to "a receptor tyrosine kinase".

II. In page 7, third paragraph of applicant's remarks, applicant argues that the amendments on claims 22-31, 33, 34, and 36 have overcome the rejection under 35 USC 112, first paragraph.

This argument has been fully considered and is moot since claims 22 and 36 is amended by deleting "a G protein mediated extracellular signal transduction pathway". These new amendments in claims 22 and 36 change scope of claims 22-31, 33, 34, and 36 so that the amendments raise new issues that would require further consideration and/or search.

III. In page 7, third paragraph of applicant's remarks, applicant argues that the amendment on claim 35 has overcome the rejection under 35 USC 112, second paragraph.

This argument has been fully considered and is moot since claim 35 is amended by adding an identifying step.

IV. In page 8, first paragraph bridging to page 9, first paragraph of applicant's remarks, applicant argues that the amendments have overcome the rejection under 35 USC 102 (a) and

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103 (a) because “[D]ong does not suggest or disclose a stimulation step prior to contacting the cell with batimastat” and “[M]iyoshi does not suggest or disclose modulating G-protein mediated signal transduction or a step of stimulating the G protein/GPCR initiated signal transduction pathway as required in the first step of the present claims followed by a second step of contacting a cell with a compound affecting a G protein mediated extracellular signal transduction pathway and thus does not cure the above discussed deficiencies in Dong”.

This argument has been fully considered and is moot since the proposed amendments on claims 22 and 36 require that stimulating step must be performed before contacting step, which is not found in claims 22 and 36 filed on July 12, 2004. The new amendments in claims 22 and 36 raise new issues that would require further consideration and/or search. Since the specification does not describe that stimulating step must be performed before contacting step, the new amendments in claims 22 and 36 also raise the issue of new matter.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (571)272-0745.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu
PSA
February 28, 2005


KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER

3/1/05